

REMARKS

Applicants have carefully considered the November 15, 2005 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance.

Claims 1-4 and 6-29 are pending in this application. Claims 27 through 29 have been withdrawn from consideration pursuant to the previous restriction requirement. Claims 9-12, 18-20 and 24-26 were allowed and claims 22 and 23 were objected to and would be allowed if recast in independent form.

In response to the Office Action dated November 15, 2005, claims 1-4 and 6-13 and 15-26 have been amended and claim 14 has been canceled. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments (FIGS. 16-21) and related discussion thereof in the written description of the specification, including page 125, lines 6-13.

Applicants submit that the present Amendment places the application in condition for allowance. At the least, the present Amendment reduces the number of issues, thereby placing this application in better condition for Appeal. Accordingly, entry of the Amendment and prompt favorable reconsideration pursuant to 37 C.F.R. § 1.116 are respectfully requested.

Claim 4 was objected to for a minor informality. Applicants have amended claim 4 consistent with the Examiner's helpful suggestion. Accordingly, reconsideration and withdrawal of the objection are solicited.

Claims 6-8 were rejected under 35 U.S.C. § 112, second paragraph. Applicants traverse. Claims 6-8 have been amended to depend from claim 4, since claim 5 was previously canceled. Therefore, it is respectfully submitted that the imposed rejection of claims 6-8 under 35 U.S.C. § 112, second paragraph is not legally viable and hence, Applicants solicit withdrawal thereof.

Claims 1-4, 6-8 and 21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Takatani et al. (U.S. Pat. No. 6,812,496, hereinafter "Takatani"). In the statement of the rejection, the Examiner referred to Figs. 4-5 and 12 of Takatani, asserting the disclosure of a semiconductor device corresponding to that defined in independent claims 1, 4 and 21, as well as dependent claims 2-3 and 6-8. Applicants respectfully traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed inventions and the device disclosed by Takatani that would preclude the factual determination that Takatani identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Claims 1, 4 and 21 have been amended, in pertinent part to describe a light-emitting diode device (LED). In contrast, Takatani fails to disclose or remotely suggest a LED and is limited in its disclosure to a semiconductor laser device. As such, Takatani fails to identically disclose each feature of the claimed inventions. Accordingly, the rejection is not legally viable for at least this reason.

Independent claims 1 and 4 further recites that LED device comprises a back electrode that is a transparent electrode. Takatani fails to disclose an LED, much less a LED comprising a transparent back electrode, as claimed. Accordingly, the rejection is not legally viable for at least this reason.

Independent claim 21 discloses a semiconductor element layer including an active layer are formed above a substrate including a region having a first thickness and a region having a second thickness smaller than the first thickness. In contrast, Takatani discloses a region having a first thickness and a region having a second thickness smaller than the first thickness formed above an active layer. Accordingly, the rejection is not legally viable for at least this reason.

Accordingly, for the reasons set forth above, the rejection of claims 1-4, 6-8 and 21 under 35 U.S.C. § 102(e) is not legally viable. Applicants, therefore, solicit the Examiner to reconsider and withdraw the rejection.

Claims 13-17 were rejected under 35 U.S.C. § 103(a) for obviousness predicated upon Takatani in view of Wilmsen et al., *Vertical-Cavity Surface-Emitting Lasers*, Design, Fabrication, and Applications, pp 4, 7 (1999). With respect to independent claim 13, the Examiner asserted that although Takatani does not teach a high resistance region formed separately from concentrated dislocations, Wilmsen discloses this limitation of claim 13. Applicants respectfully traverse.

Takatani, alone or in combination with Wilmsen, fails to disclose or suggest a LED comprising a semiconductor element layer that consists of a nitride-based semiconductor and a high resistance region including a carbon introduction layer formed by introducing the carbon. Thus, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that a requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Accordingly, independent claim 13 and claims 15-17 are free from the applied art.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter. Claims 9-12, 18-20, 24-26 were allowed. Claims 22 and 23 were objected to as being dependent upon a rejected base claim, but would be allowable if recast in independent form. However, Applicants submit that for the reasons outlined above, pending claims 1-4, 6-13 and 15-26, as amended, are in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

10/766,031

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck

Registration No. 51,321

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 BKS:idw  
Facsimile: 202.756.8087  
Date: **February 16, 2006**

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